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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,005	04/21/2004	Myron L. Munn		5504

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EXAMINER	
TAI, CYRIL	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,005

Applicant(s)

MUNN, MYRON L.

Examiner

Cyril Tai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/4/04, 6/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Sparling (US 5,766,451).

Regarding claim 2, Sparling discloses an oil filter adapter (10) (see Figs. 1 and 3), comprising;

a disc-shaped member having an engine side and a filter side (see Figs. 1 and 3);

said engine side of said disc-shaped member having an annular O-ring groove (38)

formed therein (see Figs. 1 and 3);

an O-ring (36) positioned in said O-ring groove (see Figs. 1 and 3);

said disc-shaped member having an internally threaded central opening (20) formed

therein which extends inwardly from said engine side thereof (see Fig. 3);

said disc-shaped member having an externally threaded, hollow nipple (40) extending

from its said filter side at the center thereof which is in communication with the

interior of said internally threaded central opening in said disc-shaped member

(see Fig. 3);

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said disc-shaped member having a plurality of spaced-apart unfiltered oil passageways (17) formed therein which extend therethrough from said engine side to said filter side (see Figs. 3 and 4);

said filter side of said disc-shaped member having an annular seat (24) formed therein which is positioned outwardly of said hollow nipple (see Fig. 3).

Regarding claim 2, Sparling discloses the oil filter adapter of claim 2, as discussed above, wherein the threads of said internally threaded central opening of said disc-shaped member are different than the threads on said hollow nipple (see col. 5, lines 1-5; col. 7, lines 53-59).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparling ('451) in view of Smith (US 6,355,169 B1).

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Sparling teaches an oil filter adapter (10) for attachment to the filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine, the oil filter adapter comprising:

a disc-shaped member having an engine side and a filter side (see Figs. 1 and 3);

said engine side of said disc-shaped member having an annular O-ring groove (38)

formed therein (see Figs. 1 and 3);

an O-ring (36) positioned in said O-ring groove which is adapted to sealably engage the

oil filter receptacle (see Figs. 1 and 3);

said disc-shaped member having an internally threaded central opening (20) formed

therein which extends inwardly from said engine side thereof which is adapted to

threadably receive the filtered oil tube of the oil filter receptacle (see Fig. 3);

said disc-shaped member having an externally threaded, hollow nipple (40) extending

from its said filter side at the center thereof which is in communication with the

interior of said internally threaded central opening in said disc-shaped member

(see Fig. 3);

said disc-shaped member having a plurality of spaced-apart unfiltered oil passageways

(17) formed therein which extend therethrough from said engine side to said filter

side thereof (see Figs. 3 and 4);

said filter side of said disc-shaped member having an annular seat (24) formed therein

which is positioned outwardly of said hollow nipple (see Fig. 3);

Sparling fails to teach a larger oil filter canister, having mounting threads which are different from the mounting threads of the factory oil canister, may be substituted for the standard smaller oil filter canister, the larger oil filter canister having a canister O-ring or gasket, unfiltered oil inlets and an internally threaded filtered oil outlet at one end thereof.

Smith teaches an oil filter adapter for attachment to a filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine so that a larger oil filter canister, may be substituted for the standard smaller oil filter canister, the larger oil filter canister having a canister O-ring, unfiltered oil inlets and an internally threaded filtered oil outlet at one end thereof (see col. 1, line 55 thru col. 2, line 8 and Figs. of Smith). Although Smith fails to teach a larger oil filter having mounting threads which are different from the mounting threads of the factory oil canister, Sparling teaches a hollow nipple (40) that can be configured to fit any filter as discussed below, therefore the mounting threads of the larger oil filter canister could be different from the standard smaller oil filter canister, which would have mounting threads matching the threads on an filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine.

Sparling fails to explicitly teach the threads of said hollow nipple matching the mounting threads of the larger oil filter canister. However, Sparling teaches that the hollow nipple (40) can be configured to fit any filter by changing it to a configuration to match the desired filter (see col. 5, lines 1-5; col. 7, lines 53-59).

Sparling also fails to teach the internally threaded filtered oil outlet of the larger oil filter canister selectively threadably receiving said externally threaded hollow nipple whereby the canister O-ring or gasket may be drawn into sealing engagement with said annular seat on said filter side of said disc-shaped member; and the canister O-ring of the larger canister having a larger diameter than said O-ring on said engine side of said disc-shaped member.

Smith teaches a canister O-ring of the larger canister having a larger diameter than said O-ring on said engine side of said disc-shaped member in order to allow the use of a larger oil filter than was designed for use on a particular engine, to provide increased filtering (see col. 2, lines 3-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of the teachings of Smith to have the adapter of Sparling be used with a larger oil filter canister and have a the O-ring of the larger canister have a larger diameter than the O-ring on the engine side of the disc-shaped member in order to use a larger oil filter to provide increased filtering.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cyril Tai whose telephone number is (571) 272-1495. The examiner can normally be reached on Monday-Friday from 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cyril Tai
Examiner
Art Unit 1723

CT
7/20/2006


W. L. WALKER
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